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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/425,234	10/25/1999	HAMID RABIE	4320-91	9266
1059	7590	05/05/2004	EXAMINER	
BERESKIN AND PARR SCOTIA PLAZA 40 KING STREET WEST-SUITE 4000 BOX 401 TORONTO, ON M5H 3Y2 CANADA			MENON, KRISHNAN S	
			ART UNIT	PAPER NUMBER
			1723	

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Advisory Action	Application No. 09/425,234	Applicant(s) RABIE ET AL.	
	Examiner Krishnan S Menon	Art Unit 1723	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 April 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

- 1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
- 2. ☒ The proposed amendment(s) will not be entered because:
 - (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

- 3. ☐ Applicant's reply has overcome the following rejection(s): _____.
- 4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
- 5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
- 6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
- 7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____
 Claim(s) objected to: _____
 Claim(s) rejected: 1-17 and 27-38.
 Claim(s) withdrawn from consideration: _____

- 8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
- 9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
- 10. ☐ Other: _____

Response to Amendment

Amendments to the claims will not be entered because amendments to claims 12, 13, 16, 17, and 38 raise issues that require new consideration and/or search.

Amendments to Claims 12, 16 and 17 broaden the claims. At least 10 seconds and at least 50 seconds broaden the claim from 10-100 seconds and 50 seconds and 3 minutes, respectively, because there is now no upper limit to the range. Deleting the word 'retentate' from claims 16 and 17 make them broader because now the chemical cleaner can be removed from anywhere in the system including feed, permeate and retentate, whereas before, it could be removed only from the retentate. A drain in the tank does not necessarily limit the claim any further, since one will need a means (such as a drain or a pipe connection) to remove the contents of the system. The newly added limitations of Claim 13, 'the membrane and an area in the tank water adjacent the outside of ...' are new issues requiring new consideration. Claim 38 adds the new limitation of replacing tank water with feed water before step B(c), which is also a new issue.

Response to Arguments

Applicant's arguments regarding claim 5, that 'the biocidal fluid is not backwashed in a direction opposite the direction in which the permeate normally passes through the membrane' in the Smith reference (column 17 lines 45-56): The quoted paragraph from Smith reference reads that the biocidal fluid is either recirculated through, or pulsed, using the pump 24 in the lumens of the fibers 12, and "the biocidal

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solution is under enough pressure to permit diffusion controlled flow out of the fibers".

The abstract teaches that the cleaning fluid is flowed through the permeate side of the membrane. Therefore, the quoted paragraph to support the argument actually contradicts the arguments.

Arguments re the *In re Boesch* doctrine: the rejection is based on 'optimization of a result-effective variable' as taught by *In re Boesch* and *Slaney* re the 'CT values' recited in the claims. The 'CT value' is a product of concentration of the cleaning chemicals and the duration of the cleaning process, and it would be obvious to one of ordinary skill in the art to put more chemicals and clean longer for a dirtier system.

Rest of the arguments were either addressed in the final rejection, or are moot in view of the non-entry of the amendments.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S Menon whose telephone number is 571-272-1143. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


W. L. WALKER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Krishnan Menon
Patent Examiner